

From: Sundby, Suzannah [mailto:XXXfYggfYXUWYX]  
Sent: Tuesday, March 06, 2012 9:38 PM  
To: oath\_declaration  
Subject: Inventor's Oath/Declaration (Response to Proposed Rules)

ATTN: Hiram H. Bernstein  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Dear Mr. Bernstein:

Further to my comments submitted on 3 February 2012, please consider the following:

1. With regard to proposed rule 1.32(d), I recommend that the power of attorney of an earlier application may be used in a continuing application if (1) it is from an assignee, and if (2a) the inventors of the continuing application are the same or less than that of the earlier application, or (2b) the newly added inventors have also assigned, or are under an obligation to assign, to the same assignee, and (3) the assignment to the assignee is recorded at the USPTO prior to, or concurrent with the filing of the power of attorney. Proposed rule 1.32(d) should also allow a power of attorney and a 3.73(b) Statement from a provisional application to be filed in a later application claiming the benefit of the provisional under 35 U.S.C. 119(e).

2. The supplementary comments indicate proposed amendments to rule 1.48, but the indicated amendments are not set forth in the proposed rules section. Clarification is requested.

3. With regard to proposed rule 1.63, I recommend that oath/declarations and Powers of Attorney and 3.73(b) Statements filed before 16 September 2012 are grandfathered in (from parent applications including provisional applications) and allowed to be used in pending and continuing applications. I also recommend that assignments of parent applications (including provisional applications) need not be refilled in continuing applications.

Thank you for this opportunity to comment on the proposed oath/declaration rules.

Best regards,  
Suzannah K. Sundby, Esq.  
Reg. No. 43,172

The views expressed herein are mine and are not to be attributed to any other person or entity including Smith, Gambrell & Russell, LLP or any client of the firm.

SUZANNAH K. SUNDBY | Attorney at Law  
DCbYbi aVYfgfYXUWYXQ  
www.sgrlaw.com

OX! aUj` ` UXXf Yggf YXUWYXQ

1130 Connecticut Avenue, N.W.  
Suite 1130  
Washington, D.C. 20036